

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARCIA LYNN BRANDT, JOSEPH VINCENT DICECCO,
JASON ROBERT HANSEN, THOMAS MICHAEL MOSKALIK,
TIMOTHY JUDE O'KEEFE, DIANE ELAINE OLSON,
and DEVON DANIEL SNYDER

Appeal 2007-1050
Application 10/058,360
Technology Center 2100

Decided: June 29, 2007

Before JAMES D. THOMAS, JOSEPH F. RUGGIERO,
and ALLEN R. MACDONALD, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1 through 8 and 10 through 29. We have jurisdiction under 35 U.S.C. § 6(b) and 134(a).

Representative independent claim 1 is reproduced below:

1. A computer with a data storage device including a computer usable medium having computer usable code to present a help window for a web page displayed on a monitor, the computer usable code comprising:

first computer readable code to present a web page window on the monitor, wherein the web page window includes a web page obtained from a server;

second computer readable code to receive a help request from a user for the web page;

third computer readable code to allocate a portion of the monitor for a help window in response to the help request; and

fourth computer readable code to present information to the user in the help window pertaining to the web page, wherein the information includes user-readable instructions that describe how to accomplish functions in the web page.

The following references are relied on by the Examiner:

Berry	4,789,962	Dec. 6, 1988
Dazey	5,715,415	Feb. 3, 1998
		(Filed Jun. 5, 1996)

Deken "The Early World Wide Web at SLAC: Documentation of the Early Web at SLAC" 1991

All claims on appeal, claims 1 through 8, and 10 through 29, stand rejected under 35 U.S.C. § 103. As evidence of obviousness as to claims 1, 2, 5, 6, 8, 10, 14, 15, 18, 19, 20, 21, and 24 through 29, the Examiner relies upon Deken in view of Berry in a first stated rejection. In a second stated

rejection, the Examiner adds Dazey as to claims 3, 4, 7, 11 through 13, 16, 17, 22, and 23.

Rather than repeat the positions of the Appellants and the Examiner, reference is made to the Brief and Reply Brief for Appellants' positions, and to the Answer for the Examiner's positions.

OPINION

For the reasons set forth by the Examiner in the Answer, as expanded upon here, we sustain both rejections encompassing all claims on appeal that were rejected under 35 U.S.C. § 103. Appellants effectively argue the subject matter of each independent claim 1, 8, 14, 19, 24, 25, and 27 collectively since they are within the first stated rejection. The particulars of the dependent claims rejected in this first stated rejection are not argued before us. Likewise, the particulars of the dependent claims within the second stated rejection are not argued before us.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1996). “[T]he Examiner bears the initial burden on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.3d 1443, 1445, 24 USPQ 1443, 1444 (Fed. Cir. 1992). Furthermore, “‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ [H]owever, the analysis need not seek out precise

teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)).

The reasoning provided by a recent decision from our reviewing court is also compelling as to the subject matter and arguments relative to all claims. Note *Leapfrog Enterprises, Inc. v. Fisher-Price Inc.*, 485 F.3d 1157, 1162, 82 USPQ2d 1687, 1691 (Fed. Cir. 2007). The court made it clear that the mere adaptation of an old idea or invention using newer technology, such as computers, that were commonly available and understood in the art ordinarily would have been considered an obvious improvement.

Appellants present the same three general arguments in the Brief and Reply Brief that are characterized under topics A-C. Under topic A Appellants generally urge that as to both groups of claims, that is, both stated rejections of the Examiner, the Examiner has improperly picked and chosen among isolated elements particular teachings of the respective references to Deken and Berry. Under topic B, with respect to the second stated rejections or group two, Appellants allege that the Examiner’s additional reliance upon Dazey in this rejection is improper because the reference teaches away from the proposed combination. Lastly, under topic C, Appellants urge that there is no motivation to have combined the respective references as to both stated rejections. With these particular arguments we strongly disagree.

The top of page 4 of the principal Brief notes that the parent application of this one was subject to a prior decision by a panel of this Board on November 29, 2001 in appeal number 1999-1693. This decision affirmed the examiner's rejection of all of the then pending claims on appeal under Section 103. Subsequently, this parent application was abandoned.

At the outset, we treat Appellants footnote 1 at the bottom of page 12 of the principal Brief on appeal. Although Appellants urge that Deken is not prior art under 35 U.S.C. § 102, Appellants have not presented any evidence before us that, to the extent relied upon by the Examiner, it is not prior art. Appellants have not contested before us that Deken does in fact describe activities at SLAC during the time frame of 1991 through 1994 and the Examiner has not relied upon any activities other than those set forth in Deken that have occurred with respect to this organization at that time frame. As to any arguments presented before us, Appellants have therefore waived any urging that Deken is not prior art under § 102 to the extent relied upon by the Examiner. Moreover, this reference appears to be consistent with the guidance provided by *In re Epstein*, 32 F.3d 1559, 31 USPQ2d 1817 (Fed. Cir. 1994), since Deken appears to be in a form of a general abstract of activities that were documented later in time from their actual date of occurrence.

General arguments are provided at pages 13 through 15 of the principal Brief on appeal relating to an overview of the present invention. Here Appellants make general references to the Background and Summary of the Invention. We do so likewise here. Appellants discuss their understanding of the prior art at Specification page 1, line 13 through page 2,

line 12. The paragraph bridging pages 1 and 2 recognizes that a so-called help feature was simultaneously displayed with application information to learn more about this application. The second paragraph at the top of page 2 indicates that corresponding help information was available with respect to web pages but indicates that the help page hid or otherwise replaced the web page to which it referred. Thus, the initial paragraph of the Summary of the Invention at the bottom of page 2 of the Specification as filed indicates the focus of Appellants invention was the application of the teachings of the admitted prior art with respect to application programs being applied to permit simultaneous display of help information and web page information in a web-based environment. Appellants' arguments as to topic A at pages 15 and 16 of the principal Brief on appeal essentially admit that Deken is representative of the admitted prior art at Specification page 2, lines 5 through 12, and that Berry and Dazey of the first and second stated rejections are further representations of the admitted prior art with respect to the discussion at page 1, line 26 through page 2, line 4.

Based upon Appellants' arguments in this context as well as our own review of the admitted prior art disclosed at Specification pages 1 and 2, we merely note in passing here that the artisan may have well found that the subject matter of the present claims on appeal would have been obvious to the artisan. Thus, the artisan would have found obvious to apply the known ability to simultaneously display help information and application information from an application program environment to a web-based environment. Although we recognize that these observations of our own are not the basis of the rejections before us, they are admitted by Appellants to

be consistent with the Examiner's views presented before us for decision based upon Deken and Berry, further in view of Dazey as to all claims on appeal. Moreover, we made similar observations in the paragraph bridging pages 6-7 in the prior decision noted earlier.

It is this simultaneous display of help information in a help window with web page information that is initially urged as Appellants' contribution in the art, as noted earlier, in the Summary of the Invention beginning at page 2, line 18 of the Specification as filed. This is discussed at Specification page 6, line 19 through page 7, line 2 and shown in figure 2. Likewise, figure 3 shows element 36, which is discussed at page 8, line 21 through line 27. This simultaneity feature is also summarized at the end of the Specification page 15, lines 13 and 14. This same capability is also emphasised in the discussion of the overview of the invention beginning at page 13 of the principal Brief on appeal as we noted earlier and argued as a basis of patentability in the Brief and Reply Brief.

The significance of all of this is that only one independent claim of all the claims recite positively this capability. Claim 19 merely provides the execution of browser help information simultaneously with a page obtained from the browser. This does not require the simultaneous display of the information, however. All other independent claims do not require this simultaneous display capability. Therefore, the Examiner's application of the prior art is even more applicable to the claims than as generally argued in the Brief and Reply Brief. Taken in this light, most of the claims on appeal would appear to read on the admitted prior art.

Beginning at page 4 of the Answer, the Examiner details the correlation of the teachings and showings in Deken to representative independent claim 1 on appeal. The Examiner generally recognizes that this reference does not teach that two distinct windows, one for help and one for web page, are displayed. At page 10 of the Answer, the Examiner has clarified this view by noting that Deken lacks multiple windows displayed at the same time. The Examiner's latter assessment is consistent with our view of this reference which clearly does indicate to the artisan that the web page and correspondingly desired, selected help information windows are displayed, but not at the same time. We therefore speculate whether the artisan would have considered the bulk of the independent claims on appeal to have been obvious over Deken alone.

On the other hand, the Examiner's reliance upon Berry clearly illustrates the applicability of his teachings to provide help information when called upon by a user, on the same screen as application programming information is displayed. This is illustrated in figures 2 through 4 of Berry. Notwithstanding Appellants' urgings in the Brief and Reply Brief to the contrary, the discussion partially relied upon by the Examiner but extending from column 1 to the end of that column clearly provides advantages to the artisan to have incorporated the simultaneous display capability of Berry into a web-based or web page environment. This discussion makes clear that the help information is related to the information displayed in the corresponding application page at the same time. This is characterized here as displaying information on a help screen as close to the operating point as feasible. It is also characterized as contextual help provided both in a

relational and positional sense. In addition to these advantages, the patent to Berry characterizes the help as meaningful, providing less confusion to the user and certainly providing a friendlier user interface. These same principals are summarized at column 6, lines 58 through 60 of Berry.

Dazey provides corresponding teachings and showings in figures 4 through 6 and their corresponding columnar discussions. At the same time as information is displayed in an application environment in work space 50 of figure 4, the help pane 70 is displayed to the right when requested by the user. Of particular note here is the capability of activating the table of contents button 80 and/or the show index button 90 in figures 4 through 6. The index to help content information is illustrated, as relied upon by the Examiner, as element 92 in figure 6. The advantages are set forth in the Summary of the Invention at column 2 and summarized in the paragraph at the bottom of column 6 of Dazey. In fact, the discussion in the Summary of the Invention at column 2, lines 25 through 28 indicate that the use of a help pane avoids the use of hidden application windows when a help pane has been used in the prior art, thus obviating the disadvantages of the prior art noted in the Background of the Invention at column 1.

Appellants' references to the background discussion at column 1 of Dazey at pages 17 and 18 of the principal Brief on appeal and at pages 2 and 3 of the Reply Brief, presented to us in context of teaching away from the proposed combination, are clearly misplaced. The discussion at column 1 of Dazey is not to be attributed to the teachings of Dazey per se, whereas Dazey plainly teaches that those are known disadvantages in the art discussed at column 1 that his invention addresses and overcomes. Rather

than teaching away or otherwise discouraging an artisan from following the path set out in a reference or led in a direction divergent from the path taken by an applicant, the actual teachings in Dazey overcome the same known disadvantages common to Appellants' recognition of the disadvantages of the prior art at Specification page 2 as well as those common disadvantages outlined by Dazey at column 1.

When the above noted teachings of all three references relied upon by the Examiner are respectively considered within the two stated rejections, the conclusion is inescapable to us that the Examiner has not improperly picked and chosen certain elements of the prior art for certain features of the claimed invention as alleged at pages 15 and 16 of the principal Brief on appeal and again at page 2 of the Reply Brief. Likewise, Appellants' urging at pages 18 through 20 of the principal Brief on appeal and at pages 4 and 5 of the reply Brief that there is no motivation to have combined the respective teachings is clearly misplaced. On the contrary, there appears to us that substantial evidence of unpatentability has been presented by the Examiner of the subject matter in the claims on appeal. The desirability of the combination is clearly made available to the artisan according to the teachings and showings of the applied prior art as well as the Examiner's reasoning. Therefore, since the Examiner has clearly used teachings and showings of the prior art, no valid argument of the Examiner exercising prohibited hindsight reasoning is seen.

In view of the foregoing, the decision of the Examiner rejecting all claims on appeal under 35 U.S.C § 103 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. §1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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